

REMARKS

Applicants have studied the Office Action dated January 24, 2006. Reconsideration and allowance of the pending claims in view of the following remarks is respectfully requested. Claims 1-4, and 10-22 remain pending in the application. Reconsideration and allowance of the pending claims in view of the above amendments and the following remarks are respectfully requested. Applicants submit that this response does not raise new issues in the application. It is submitted that the present response places the application in condition for allowance or, at least, presents the application in better form for appeal. Entry of the present response is therefore respectfully requested.

In the Office Action, the Examiner:

- Rejected claims 1-4, and 10-22 under 35 U.S.C. § 112, second paragraph as being incomplete for omitting essential steps; and
- Rejected claims 1-4 and 10-22 under 35 U.S.C. § 103(a) as being unpatentable over James (U.S. Patent 6,934,717) in view of Foster et al. (U.S. 6,853,727).

Rejection under 35 U.S.C. §112, Second Paragraph

As noted above, in the Office Action, claims 1-4, and 10-22 were rejected under 35 U.S.C. § 112, second paragraph as being incomplete for omitting essential steps. Specifically, the Examiner alleges on page 2 of the Office Action "*The omitted steps are: the steps of retrieving an encrypted file is decrypted. As the claims are currently presented, there is no mention of an encryption step, and the delineated step of decrypting is performed on a file that is not encrypted. Decryption is an applied process that needs a prerequisite step of encryption and that is not disclosed in the newly amended claim. Therefore, the claims is seen as omitting essential steps. For the purposes of examination, the file that is being decrypted is assumed to be previously encrypted.*" The Applicants respectfully traverse with the Examiner's rejection. As the Examiner correctly states, decryption is an applied process; however it is not essential

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that one type of encryption or decryption be used in the claimed invention. Stated differently, it is possible to have a set of claims in the present invention direct to the step of storing encrypted content, retrieving encrypted content, or both. To avoid further election requirements, the claims in the present application are directed to retrieving previously encrypted content. The present invention detects tampering of locally stored electronic digital content by uniquely tracking updates to the electronic digital content. This is especially important in situations where the electronic digital content is licensed only for a limited number of plays or for a limited time. Unlike prior art systems, if a user of the present invention simply re-installs or re-downloads the identical electronic digital content into their own library, the present invention detects these updates to the electronic digital content and eliminates the problem of over-writing, over-riding, or otherwise circumventing the original license conditions for the identical content. The present invention detects tampering of locally stored electronic digital content through use of a database or, in its simplest form, a data table for storing encrypted location indicators to the data items that form the encrypted digital content. This is clearly illustrated in FIGs 20-25 and described in pages 165-172 of the specification in the present invention as originally filed.

The Examiner cites MPEP §2172.01, which states "*But see Ex parte Nolden, 149 USPQ 378, 380 (Bd. Pat. App. 1965) ('[I]t is not essential to a patentable combination that there be interdependency between the elements of the claimed device or that all the elements operate concurrently toward the desired result'); Ex parte Huber, 148 USPQ 447, 448-49 (Bd. Pat. App. 1965) (A claim does not necessarily fail to comply with 35 U.S.C.112, second paragraph where the various elements do not function simultaneously, are not directly functionally related, do not directly intercooperate, and/or serve independent purposes.)*" In the present claims, the encryption does not function simultaneously with the decryption process and therefore do not necessarily intercooperate. In fact most users download content locally in content libraries for playback at later times such as the popular Apple iTunes musical store. The encrypted content even though it is stored only once locally is available for repetitive decryption

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and playback for the user. This is no different than a DVD having been encrypted or encoded at the manufacturer and then played back at the users DVD player. Further, the present invention operates even if the content is encrypted on a machine, such as a server e.g. Apple iTunes, which is separate from the client playback machine. The encryption process on the server or even locally is a distinct and separate from the process to manage a library of encrypted content by checking for updates prior to decrypting and playing back the encrypted content.

The Office Action on page 3, correctly states *"for the purposes of examination that the file (a reference table) that is being decrypted is assumed to be previously encrypted."* Therefore, this interpretation even goes to the weight that the step of encrypting is assumed to happen separate, not simultaneously, and independent of the decrypting the table.

Accordingly, the Applicants respectfully submit that the subsequent process of encryption is separate and distinct from the process claimed in the present invention of decrypting the content only after determining if there are any updates and that the Examiner's rejection under 35 U.S.C. § 112, second paragraph should be withdrawn.

Commonly Owned Reference under 35 U.S.C. 35 U.S.C. § 103

Applicants submit that under 35 U.S.C. § 103 (c), the subject matter of Foster et al (U.S. 6,853,727) cited by Examiner and of the presently claimed invention was commonly owned at the time the claimed invention was made, and that this effectively disqualifies the cited reference as prior art under 35 U.S.C. § 103 (c) for purposes of an obviousness rejection. See also MPEP § 706.02 (I) (3), specifically directing Examiners to check the assignment records to determine common ownership. Note that the cited reference Foster and the subject matter of the presently claimed invention have been and are currently assigned to the same common owner, i.e., the International Business Machines Corporation. Note also that the date of the Foster reference is March 23,

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2000, while the file date of the present patent application is June 19, 2001. The Foster reference, accordingly, is being cited under 35 U.S.C. § 102(e)/103(a) for an obviousness rejection. Therefore, on this rejection basis discussed above, Applicants submit that the subject matter of the Foster reference should be disqualified from relevant prior art under 35 U.S.C. § 103 (c) for purposes of an obviousness rejection. However, additional arguments are given below in the section entitled "Rejection under 35 U.S.C. §103(a)."

Rejection under 35 U.S.C. §103(a)

As noted above, the Examiner rejected claims 1-4 and 10-22 under 35 U.S.C. § 103(a) as being unpatentable over James (U.S. Patent 6,934,717) in view of Foster et al. (U.S. 6,853,727). To begin, Foster has been disqualified from relevant prior art under 35 U.S.C. § 103 (c) for purposes of an obviousness rejection.

The Examiner cites James at column 6, lines 13-58, column 6, lines 47-57, and column 10 lines 7-29 for allegedly teaching the claim element of independent claims 1, 10, 11, and 15:

"decrypting, with the first decrypting key, a reference table containing one or more location indicators for storing the data items in a data table; and
populating the data table with the data items at locations specified by the location indicators in the reference table."

However, careful reading of James teaches that the index is populated after the table is created and not vice-versa. See for example James column 6, lines 48-53. James is completely silent on using the index 206 (the reference table) for populating the data table 215. Accordingly, the Applicants respectfully submit that using the index 206 in James to populate the data table destroys the intent of James of using the index table to making index searching faster. Stated differently, James teaches the index is used to point to data stored in the table. This is in contrast to the present invention where the

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index is used to populate the data table. Moreover, the Federal Circuit has consistently held that when a §103 rejection is based upon a modification of a reference that destroys the intent, purpose or function of the invention disclosed in the reference, such a proposed modification is not proper and the *prima facie* case of obviousness can not be properly made. See *In re Gordon*, 733 F.2d 900, 221 USPQ 1125 (Fed. Cir. 1984). Accordingly, the present invention distinguishes over James for at least this reason, as well.

Further, even if James and Foster are combined as suggested by the Office Action, they fail to disclose all the limitations of the claimed invention. Foster explicitly teaches storing the data blocks in memory and then updating the file allocation table (index). See Foster col. 3, lines 23-27 and the sequence of items 340, 345 and 355 in FIG. 3.

Moreover, Applicants submit that the combination of James with Foster *teaches away* from "populating the data table with the data items at locations specified by the location indicators in the reference table". In both James and Foster the data table is populated before the reference table (index in James or file allocation table in Foster). In both James and Foster, a person of ordinary skill in the art would not have this within their grasp. Rather, the person of ordinary skill would have to flush out only by reliance upon the teaching of the present invention and not the teachings of James alone and/or in combination of Foster.

That James does not disclose decrypting the reference table is conceded by the Office Action. However, the Office Action alleged that all that is missing from James is the "decrypting, with a first decrypting key." As readily seen, adding decrypting to James does not result in a disclosure of the claimed invention since it still lacks the ability to provide "*populating the data table with the data items at locations specified by the location indicators in the reference table*" as recited in the independent claims 1, 10, 11, and 15. Claims 2-4, and 12-22 depend from independent claims 1 and 11 respectively,

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since dependent claims contain all the limitations of the independent claims, claims 2-4, and 12-22 distinguish over James taken alone and/or in view of Foster as well and the Examiner's rejection should be respectfully withdrawn.

CONCLUSION

In this Response, Applicants have amended certain claims. In light of the Office Action, Applicants believe these amendments serve a useful clarification purpose, and are desirable for clarification purposes, independent of patentability. Accordingly, Applicants respectfully submit that the claim amendments do not limit the range of any permissible equivalents.

Applicants acknowledge the continuing duty of candor and good faith to disclosure of information known to be material to the examination of this application. In accordance with 37 CFR § 1.56, all such information is dutifully made of record. The foreseeable equivalents of any territory surrendered by amendment is limited to the territory taught by the information of record. No other territory afforded by the doctrine of equivalents is knowingly surrendered and everything else is unforeseeable at the time of this amendment by the Applicants and their attorneys.

Applicants respectfully submit that all of the grounds for rejection stated in the Examiner's Office Action have been overcome, and that all claims in the application are allowable. No Previously Presented matter has been added. It is believed that the application is now in condition for allowance, which allowance is respectfully requested.

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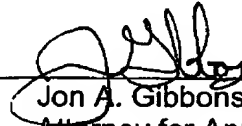
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PLEASE CALL the undersigned attorney at (561) 989-9811 should the Examiner believe a telephone interview would help advance prosecution of the application.

Respectfully submitted,

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